



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/671,822

01/20/2004

Henry Daniell

CHL-T103XCD1

8476

23557

7590

01/27/2006

SALIWANCHIK LLOYD & SALIWANCHIK
A PROFESSIONAL ASSOCIATION
PO BOX 142950
GAINESVILLE, FL 32614-2950

EXAMINER

KUBELIK, ANNE R

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/671,822	Applicant(s) DANIELL, HENRY	
	Examiner Anne R. Kubelik	Art Unit 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 08 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claim 1 is pending.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. The rejection of claim 1 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, new matter, is withdrawn in light of Applicant's amendment of the claim.
4. The rejection of claim 1 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn in light of Applicant's amendment of the claim.
5. The rejection of claim 1 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement is withdrawn in light of Applicant's amendment of the claim.
6. The rejection of claim 1 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention is withdrawn in light of Applicant's amendment of the claim.

Claim Rejections - 35 USC § 103

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maliga et al (US Patent 5,877,402, filed January, 1994) in view of Davies et al (WO 90/11770). The rejection is repeated for the reasons of record as set forth in the Office action mailed 6 July 2005. Applicant's arguments filed 8 November 2005 have been fully considered but they are not persuasive.

Art Unit: 1638

Applicant urges that it was not obvious to engineer the plastid genome to confer disease resistance; there were no reports or suggestions in the literature that the plastid genome could be so engineered (response pg 6).

This is not found persuasive because both Maliga et al (column 27, lines 34-42) and Smith et al (below, WO 99/06564, pg 5, lines 3-11, and pg 9, lines 23-27) suggest doing so.

Applicant urges that combating phytopathogens by the present invention is contrary to all current understanding of chloroplast biology because small peptides are highly susceptible to proteolytic degradation; Magainin-type peptides are chemically synthesized, not made in biological systems for that reason (response pg).

This is not found persuasive. Applicant presents no evidence that expression of small peptide in plastids was not thought possible. Furthermore, Applicant did nothing more than was already suggested in the art for expressing MSI-99; the plastid transformation vector used has no special feature and the claim is not drawn to any special feature.

8. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maliga et al (US Patent 5,877,402, filed January, 1994) in view of Smith et al (WO 99/06564). The rejection is repeated for the reasons of record as set forth in the Office action mailed 6 July 2005.

Applicant's arguments filed 8 November 2005 have been fully considered but they are not persuasive.

Applicant urges that Smith et al provides examples based on nuclear transformation, not plastid transformation (response pg 6).

This is not found persuasive. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the

Art Unit: 1638

rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant urges that while Smith et al may suggest plastid transformation, they do not appreciate the unexpected advantages disclosed by the present invention (response pg 6-7).

This is not found persuasive. Smith et al successfully produced disease resistant plants with nuclear transformation (pg 18-34) and suggest that disease resistant plants could be produced with plastid transformation (pg 5, lines 3-11, and pg 9, lines 23-27). Applicant's arguments would only apply if Smith et al could not produce disease resistant plants with nuclear transformation. Applicant has not produced evidence of unexpected results.

Applicant urges that Maliga in view of Smith does not provide an expectation of success (response pg 7).

This is not found persuasive because, as discussed above, every expectation of success is provided.

Conclusion

9. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne R. Kubelik, whose telephone number is (571) 272-0801. The examiner can normally be reached Monday through Friday, 8:30 am - 5:00 pm.

Art Unit: 1638

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg, can be reached at (571) 272-0975.

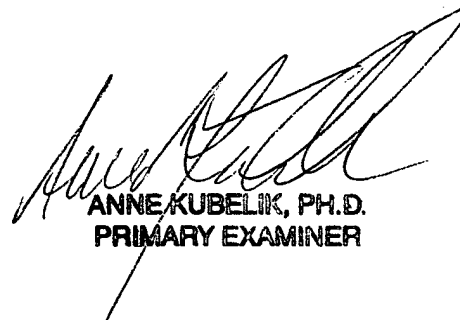
The central fax number for official correspondence is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Anne Kubelik, Ph.D.
January 20, 2006



ANNE KUBELIK, PH.D.
PRIMARY EXAMINER